REMARKS

The Office Action dated April 4, 2007, has been reviewed in detail and the application has been amended in the sincere effort to place the same in condition for allowance. Reconsideration of the application and allowance in its amended form are requested based on the following remarks.

Applicants retain the right to pursue broader claims under 35 U.S.C. §120.

Applicants have provided a unique solution with respect to problems regarding MONITORING AND DATA EXCHANGE PROCEDURE FOR A PERIPHERAL DATA STORAGE UNIT. Applicants' solution is now claimed in a manner that satisfies the requirements of 35 U.S.C. §102 and §103.

Rejection of Claims 21, 23-25, and 34 Under 35 U.S.C. §102:

Claims 21, 23-25, and 34 were rejected under 35 U.S.C. §102 as being anticipated by Kokubun (U.S. Patent Publication 2002/0023198). Claims 21, 23-25, and 34 have been canceled herein, without prejudice, thereby rendering the present rejection moot.

Rejection of Claims 22, 23, 26-33, and 35-40 Under 35 U.S.C.

§103:

Claims 22, 23, 26-33, and 35-40 were rejected under 35 U.S.C. §103 for the reasons set forth on pages 5-14 of the outstanding Office Action. Claims 22, 23, and 35-40 have been canceled herein, without prejudice, thereby rendering the present rejection against these claims moot. Claims 26-33 have not been canceled and will be discussed herein.

Claims 26-29 were rejected under 35 U.S.C. §103 as being unpatentable over Kokubun in view of Jones (U.S. Patent 6,438,638). In general, the Examiner stated that Kokubun showed all of the features of Claim 26 except the step of "manually actuating, by a physical movement of a user, said signal generator in said external data storage unit, independently of all other functions and functioning of said computer and subsequent to operatively connecting said external data storage unit to said computer, and generating a signal." The Examiner stated that the above step is disclosed by Jones. The Examiner concluded that it would have been obvious to combine Kokubun and Jones to incorporate Jones' pushbutton into KO's

14

overall system to provide a simple user interface to operate the external data storage unit and initiate data transfer.

Kokubun, as best understood, shows a docking station 12 to which a computer 10 may be mounted. The docking station 12, among other things, has a hard disk device 16. In a data backing up or mirroring process, data can be transferred between the computer 10 and the docking station 12. In operation, the computer 10 contains a program that controls the data transfer. The program on the computer 10 can be set to execute an immediate, automatic transfer of data upon mounting of the computer 10 on the docking station 12 (Kokubun, para. 0058-0064). Alternatively, a user of the computer 10 can input commands into the computer 10 via the keyboard to initiate the transfer of data, but only if the automatic synchronization feature is turned off (Kokubun, para. 0065). Otherwise, the automatic synchronization/data exchange occurs immediately upon connection of the computer 10 and docking station 12.

Jones shows a flash-memory-card reader for reading and writing data from flash memory cards of different types. As shown in Fig. 9 of Jones, the so-called FlashToaster can accept various types of

15

flash cards for transfer of data from the cards to removable mass

storage 70 or directly onto a computer 20. Jones also states the

following in column 4, lines 57-63:

> In a third embodiment, the CompactFlash reader is a
> stand-alone device that can operate **without a PC.** A removable
> disk media such as a R/W CD-ROM is included. Images from
> the flash-memory card are copied to the removable disk media
> by the CompactFlash reader. A simple interface is used, such
> as having the user presses a button to initiate image transfer.
> (emphasis added)

Jones further describes the above embodiment, shown in Figure 9, in

column 10, lines 26-30:

> FlashToaster 80 is provided with a simple user interface,
> including light-emitting diode LED 78 and button 79. When the
> user inserts a flash-memory card into one of connectors 62, 64,
> 66, 68, and removable disk 76 is inserted into removable mass
> storage 70, the user presses button 79. This activates controller
> chip 40, which determines which of connectors 62, 64, 66, 68
> has a memory card inserted, and copies the image files to
> removable mass storage 70.

Jones therefore teaches that the button interface is used only to

transmit data from a flash-memory card onto removable media, such

as a CD, in a stand-alone device which operates without a PC. The

push button does not initiate a data exchange between the computer

and the FlashToaster. Further, Jones states the following from

column 9, line 66, to column 10, line 5:

16

Converter chip 40 executes various routines to perform handshaking with the flash-memory cards and accept data, either serially or in parallel. The data is buffered and then sent either to host PC 20 through USB connector 46 or to removable mass storage 70. Converter chip 40 generates the appropriate USB-interface signals to transfer the data to host PC 20.

Jones therefore teaches that the transfer of data to the PC 20 is initiated and controlled by the converter chip 40, not by button 79. The data transfer appears to be automatic because the converter chip 40 buffers and sends the data to the PC 20 when connected. Such an interpretation fits with the teachings of Jones because the only reason for the FlashToaster 80 to be connected to a PC 20 would be to upload the data from smaller, temporary storage (memory card in FlashToaster 80) to larger, more permanent storage (hard drive in PC 20). An automatic upload onto the PC would be expected and probably desirable to users since there would be essentially no other goal or outcome that would be sought from connecting the FlashToaster 80 to the PC 20. Further, the button 79 is clearly used only in what could be described as a "portable" setting when the user is away from his or her PC. The button 79 provides an easy interface for a user to move data, such as digital pictures, only when desired off of a flash drive and onto a higher-

17

capacity removable disk 76 upon the flash drive approaching full capacity. The button 79 is not used to initiate a data transfer onto the PC 20 since the data transfer is automatically controlled and initiated by the converter chip 40 upon connection for the ease of the user in uploading data onto the PC.

It is respectfully submitted that the above combination of Kokubun and Jones is improper as it does not satisfy all three requirements necessary to establish a *prima facie* case of obviousness as set forth in MPEP §2143:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

> The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

First, there is no reasonable expectation of success in combining Kokubun and Jones. In Kokubun, a program on the computer automatically controls the transfer of data between the computer 10 and the docking station 12, either immediately upon

18

connection or at a scheduled time. In Jones, the converter chip 40 in the external FlashToaster 80 controls the automatic transfer of data to the PC 20 upon connection thereto. Major modifications would therefore have to be made to either Kokubun or Jones in order to combine the two since the two controlling parts - the computer program in Kokubun and the converter chip in Jones - cannot both control the same process (the data exchange) at the same time and would in a sense "fight" over control. Some sort of conflict would occur between the two, which would probably render such a combination inoperable.

In addition, the button 79 of Jones is only used to transfer data within the FlashToaster 80 itself from a flash-memory card to a removable disk 76. The button 79 never initiates a transfer between the FlashToaster 80 and the PC 20. Thus, Jones would again have to be significantly modified in a manner not taught or suggested by either Kokubun or Jones to cause the button 79 to initiate a transfer of data to the computer of Kokubun. Alternatively, Kokubun would have to be significantly modified to prevent the automatic data transfer that occurs upon connection of an external device and the computer in order to subject the data transfer to control by the

19

button 79 of Jones. The whole operating program of Kokubun would

have to be rewritten in a manner not contemplated or taught by

Kokubun in order to be only responsive to signals from the button 79

of Jones. There are therefore several obstacles to the successful

combination and operation of the computer 10 of Kokubun with the

FlashToaster 80 of Jones, and thus there is no reasonable

expectation of success in combining the two to perform the method

as claimed in Claim 26 or new Claim 47.

Further, even if there were a reasonable expectation of success

in combining Kokubun and Jones, the combination does not teach or

suggest all of the claim limitations, as required by MPEP §2143. In

that regard, amended Claim 26 recites:

> A method of monitoring and exchanging data between an
> external data storage unit and a computer, said computer
> comprising a connection port, said external data storage unit
> comprising a connecting device, an actuator, and a signal
> generator, said method comprising the steps of:
> running a program on said computer and monitoring, with
> said program, said connection port for a signal from said
> external data storage unit;
> operatively connecting said connecting device of said
> external data storage unit to said connection port of said
> computer;
> manually actuating, by a physical movement of a user of
> said actuator, said signal generator in said external data
> storage unit, independently of all other functions and functioning
> of said computer and subsequent to operatively connecting said

20

external data storage unit to said computer, and generating a
signal;

initiating with said program a data exchange between said
external data storage unit;

initiating with said program a data exchange between said
external data storage unit and said computer in response to
detection of said generated signal by said program; and

exchanging data between said external data storage unit
and said computer.

The above-claimed method involves, in part, manually actuating
an actuator of the external data storage unit, and thus the signal
generator of the external data storage unit, to generate a signal.
The signal is detected by a program running on the computer, and in
response the program on the computer initiates a data exchange
between the external data storage unit and the computer. Assuming
Kokubun and Jones could be combined, the combination does not
teach or suggest these steps. Jones, as discussed above, teaches
manual actuation of an actuator, i.e. button 79, to initiate a data
transfer from a flash-memory card to a removable disk 76 only within
the external data storage unit, i.e. FlashToaster 80. No data is
exchanged with the PC 20 and the FlashToaster 80 is not even
connected with the PC 20 when the button 79 is used. Kokubun, as
admitted in the outstanding Office Action, does not teach or suggest
any type of manual actuation by physical movement of a user of an

21

actuator independent of the computer.

Finally, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings, as required by MPEP §2143. Both Kokubun and Jones teach away from using a button or other manual system to control data transfer between an external device and a computer as they both teach only automatic data transfer between such devices. Again, Kokubun shows a computer 10 that has a program for initiating any transfer of data. The docking station 12 of Kokubun also does not contain a signal generator as recited in Claim 26 that is manually actuated "independently of all other functions and functioning of said computer." Jones shows an external device in the form of the FlashToaster 80 as discussed above and shown in Figure 9 of Jones. However, Jones teaches that the FlashToaster is only activated by using a push button when the FlashToaster is operating as a stand-alone unit without a PC, and only to transfer data in the form of photographic images one way from the flash-memory card onto removable media, such as a CD, and not a computer. The push button does not initiate a data exchange between the computer and

22

the FlashToaster. Instead, like Kokubun, Jones apparently teaches that data be automatically transferred by the converter chip 40. Both Kokubun and Jones therefore teach away from using a manual actuator of an external data storage unit to signal a computer program on a computer to initiate data transfer between the computer and the external data storage unit. Further, since there is nothing in the applied references to teach that they be combined, it is also submitted that the only motivation to combine the applied references is the present disclosure itself, and such hindsight analysis of the available art is considered improper.

In view of the above, Claim 26 and new Claim 47, which recites similar limitations as Claim 26, are believed to distinguish over and not be rendered obvious by the combination of Kokubun and Jones as the combination of Kokubun and Jones is improper as it fails to satisfy any of the three requirements for establishing a *prima facie* case of obviousness in accordance with MPEP §2143. The additional combinations of Kokubun, Jones, and Morioka (U.S. Patent 6,292,878) and McFedries ("Complete Idiot's Guide to Windows XP") are also believed to be improper since the base combination of Kokubun and Jones is improper.

In addition, the method as claimed in Claim 26 presents a significant advantage over the methods taught by Kokubun and Jones. Both of these references teach automatic transfer of data upon connection of a computer and an external device. Although such automatically-executed actions can be desirable for the purpose of saving time and effort, especially for novice users of computers and other digital equipment, they can also be very undesirable in the event a data exchange was not wanted. For example, suppose a user of the system of Kokubun connects the computer 10 to the docking station 12, but then realizes that there is data on either the computer 10 or the docking system 12 that the user does not want to be transferred, or realizes that he or she forgot to turn off the automatic data transfer setting. Unfortunately for the user, the automatic transfer would immediately begin and it would be too late to stop the error. The same would also be true in the system of Jones, wherein data would be uploaded automatically onto the PC. Such erroneous data transfers could be problematic, especially if the data transferred or exchanged contained malicious programming or private information. In the method of Claims 26 and 47, the data exchange does not commence automatically with the connection of

24

the external data storage unit and the computer, but rather is only initiated at the discretion of the user. Consequently, unintentional automatic data transfers or exchanges could be avoided to the benefit of the user.

In view of the above, Claims 26 and 47, as well as the claims dependent therefrom, are therefore believed to distinguish over and not be rendered obvious by the applied references based on the distinguishing features recited therein and the impropriety of the combination.

In view of the above, reconsideration and withdrawal of the present rejection is respectfully requested.

Petition for Extension of Time under 37 C.F.R. §1.136(a):

Applicants hereby petition for a one-month extension of time, from July 4, 2007 until August 4, 2007, in which to file the present amendment in the above-cited case. A payment in the amount of $120.00, representing the one-month extension fee for a large entity, is submitted herewith.

Art Made of Record:

The prior art made of record and not applied has been carefully reviewed, and it is submitted that it does not, either taken singly or in any reasonable combination with the other prior art of record, defeat the patentability of the present invention or render the present invention obvious. Further, Applicants are in agreement with the Examiner that the prior art made of record and not applied does not appear to be material to the patentability of the claims currently pending in this application.

In view of the above, it is respectfully submitted that this application is in condition for allowance, and early action towards that end is respectfully requested.

Summary and Conclusion:

It is submitted that Applicants have provided a new and unique MONITORING AND DATA EXCHANGE PROCEDURE FOR A PERIPHERAL DATA STORAGE UNIT. It is submitted that the claims, as presented herein, are fully distinguishable from the prior art. Therefore, it is requested that a Notice of Allowance be issued at an early date.

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Respectfully submitted,

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